

Docket No. 60341-USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Jean LeBlanc, *et al.*

US Application No.: 10/588,915

Filing Date: September 2, 2008

International Application: PCT/US/2005/004353

Filing Date: February 9, 2005

Title: Method for Control of Ground Shoots of Vines and Other Trunk Vegetation

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT COVER LETTER

Pursuant to 37 CFR § 1.56 and in accordance with 37 CFR §§ 1.97-1.98, attached is an Information Disclosure Statement relating to the above-identified application.

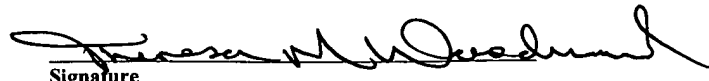
Note – Complete only one of 1, 2 or 3 below

1. ☒ In accordance with § 1.97(b), this Information Disclosure Statement is being filed either:
- a) within three months of the filing date of the above-identified application,
 - b) within three months of the date of entry into the national stage of the above-identified application as set forth in § 1.491,
 - c) before the mailing date of a first Office Action on the merits of the above-identified application, or
 - d) before the mailing date of a first Office Action after the filing of a request for continued examination under § 1.114, and no additional fee or certification is required.

CERTIFICATION UNDER 37 C.F.R. 1.8(a)

I hereby certify that, on the date shown below, this correspondence (along with any referred to as being enclosed) is being deposited with the United States Postal Service in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with sufficient postage as first class mail.

Date: Feb. 25, 2009


Signature
THERESA M. WOODWARD
(type or print name of person certifying)

2. ☐ In accordance with § 1.97(c), this Information Disclosure Statement is being filed after the period set forth in § 1.97(b) above, but before the mailing date of either a Final Action under § 1.113 or a Notice of Allowance under § 1.311, or before an action that otherwise closes prosecution in the application, therefore:

☐ The following Certification in Accordance with § 1.97(e) is provided;

☐ a) "I hereby certify that each item of information contained in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement."

OR

☐ b) "I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign Patent Office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement."

OR

☐ the fee of \$180.00 as set forth in § 1.17(p) which should be charged to Deposit Account No 06-1440.

3. ☐ in accordance with § 1.97(d), this Information Disclosure Statement is being filed after the mailing date of either a Final Action under § 1.113 or a Notice of Allowance under § 1.311, but before, or simultaneously with, the payment of the Issue Fee; therefore, included are the following: Certification in Accordance with § 1.97(e); and the fee of \$180.00 as set forth in § 1.17(p).

☐ a) "I hereby certify that each item of information contained in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement."

OR

☐ b) "I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign Patent Office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

AND

☐ The fee of \$180.00 as set forth in §1.17 which should be charged to Deposit Account No. 06-1440

4. ☒ Copies of the following which refer to at least one of the documents listed on the IDS are enclosed:

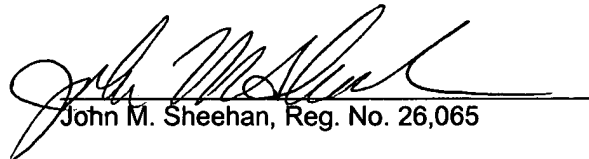
Letter from Manelli Denison & Selter PLLC, dated January 23, 2009

If foreign patents and non-patent literature references are listed on the attached forms PTO-SB08a and PTO-SB08b, copies are enclosed herewith. The Examiner is respectfully requested to consider the cited references, initial the forms and return copies of such. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 CFR § 1.56(b).

Please charge any deficiency or credit any overpayment to Deposit Account No. 06-1440.

The Examiner is invited to contact the undersigned at the telephone number set forth below if the undersigned can be of any assistance in expediting the prosecution of this application.

Date: 2/25/09


John M. Sheehan, Reg. No. 26,065

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January 23, 2009

John M. Sheehan
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VIA U.S. CERTIFIED MAIL



Subject: In re U.S. Patent Application of LeBlanc et al.
Serial No. 10/588,915
Pub. No.: US 2008/0312081 A1
Assignee: FMC Corporation, Philadelphia, PA

60341

Dear Mr. Sheehan:

The subject patent application, No. 10/588,915 (US '915), has come to the attention of a company which I represent. Upon review of the application and claims, it is believed that several prior art publications render the claims to be unpatentable. These include the following five publications, and copies of the publications are enclosed with this letter:

- 1) "Goal 2XL Herbicide," Rohm and Haas Company (2002), pp 1-6;
- 2) George, Ann, "Crop Profiles for Hops in Washington," Washington Hop Commission (2001), pp. 1-11;
- 3) Comite D'Homologation "Produits phytosanitaires" Séance du 8 Decembre 2003, Ministere De L'Agriculture, De L'Alimentation, De La Peche Et Des Affaires Rurales (2003), pp. 1-14;
- 4) "SPOTLIGHT PLUS," Societe: FMC Chemical, SPRL, Ministere De L'Agriculture et De La Peche (2004) p. 1; and
- 5) Boger, P. et al. "Herbicide Classes in Development Mode of Action, Targets, Genetic Engineering, Chemistry," Springer (2002) pp. 254-259.

We ask you to consider the publications and our following brief comments regarding the relevance of the publications.

1) Goal 2XL Herbicide, Rohm and Haas Company

This document is a pesticide label of GOAL 2XL which contains oxyfluorfen (see page 1 under Active Ingredient). Oxyfluorfen is known to be one of protoporphyrinogen

oxidase (PPO) enzyme inhibiting herbicides. The use of PPO enzyme inhibiting herbicide is recited in the method claims 1, 5, 6, 7 and 10 of US '915. The use of oxyfluorfen is specifically recited in claim 5 of US '915. Please note that the reference describes the use of GOAL 2XL herbicide for effective control/suppression of suckers on grapevines. GOAL 2XL is applied as a directed ground spray to suckers growing from the base of the plant (see page 3, under General Information). The term, "sucker" is synonymous with "ground shoots."

The sole independent claim 1 recites the use of all PPO enzyme inhibiting herbicides for control of ground shoots of vines and other trunk vegetation, and thus the GOAL reference renders all US '915 claims to be unpatentable. Those claims whose scope specifically includes oxyfluorfen are further unpatentable.

2) George, Ann, Crop Profiles for Hops in Washington

This document discloses the use of carfentrazone-ethyl to control sucker growth. Carfentrazone-ethyl is known to be one of PPO enzyme inhibiting herbicides, discussed above with regard to the first reference. The use of PPO enzyme inhibiting herbicide is recited in the method claims 1, 5, 6, 7 and 10 of US '915. The method of using carfentrazone-ethyl to control sucker growth (ground shoots) is specifically recited in claims 5, 6, 7, 9, and 12 of US '915. Please refer to the right column of page 8, lines 4 to 7 of the present George reference, which expressly discloses the use of carfentrazone-ethyl to better control basal sucker growth. Hop is encompassed by the applicable target "vines and other trunk vegetation" of the US '915 claims. Please note that all the Examples set forth in US '915 employ carfentrazone-ethyl as the PPO enzyme inhibiting herbicide.

The sole independent claim 1 recites the use of all PPO enzyme inhibiting herbicides for control of ground shoots of vines and other trunk vegetation, and thus the George reference renders all US '915 claims to be unpatentable. Those claims whose scope specifically includes carfentrazone-ethyl are further unpatentable.

3) Comite D'Homologation Produits phytosanitaires Séance du 8 Decembre 2003

This document contains a report of the French committee of approval for plant protection, session of December 8, 2003, regarding agrochemical registration. At page 4, there appears a recitation of SPOTLIGHT PLUS for use in controlling shoots of vines. SPOTLIGHT PLUS appear to be at least one of the trade names of carfentrazone-ethyl based on the description in the US '915 application. Please note, for example, the disclosure regarding SPOTLIGHT PLUS at page 3, column 2, paragraph 0031, line 3 of the published US '915 (Patent Application Publication No.: US 2008/0312081 A1, December 18, 2008). The present Comite D'Homologation reference thus discloses

methods for using carfentrazone-ethyl herbicides to control unwanted ground shoots of vines and other trunk vegetation.

As discussed above, carfentrazone-ethyl is known to be one of PPO enzyme inhibiting herbicides. The use of PPO enzyme inhibiting herbicides is recited in the method claims 1, 5, 6, 7 and 10 of US '915. The method of using carfentrazone-ethyl to control sucker growth (ground shoots) is specifically recited in claims 5, 6, 7, 9, and 12 of US '915.

The sole independent claim 1 recites the use of all PPO enzyme inhibiting herbicides for control of ground shoots of vines and other trunk vegetation, and thus the *Comite D'Homologation* reference renders all US '915 claims to be unpatentable. Those claims whose scope specifically includes carfentrazone-ethyl are further unpatentable.

4) SPOTLIGHT PLUS, Societe: FMC Chemical, SPRL

This document identifies SPOTLIGHT PLUS to contain carfentrazone-ethyl and thus supports the relevance of the above discussed document, *Comite D'Homologation* "Produits phytosanitaires" Séance du 8 Decembre 2003. Further, the carfentrazone-ethyl is disclosed in the present reference for use in destruction/control of unwanted growth in hops vines and grape vines. See the above discussions for references 2 and 3 regarding the disclosure of using carfentrazone-ethyl as a herbicides for control of ground shoots of vines and other trunk vegetation, to render the claims of US '915 to be unpatentable.

5) Boger, P. et al. Herbicide Classes in Development Mode of Action

This document explicitly discloses herbicidal compounds claimed for use in the US '915 application including oxyfluorfen, in Figure 31, at page 256 of the reference, carfentrazone-ethyl in Table 16, at page 258 of the reference, and further the PPO enzyme inhibiting herbicide, pyraflufen-ethyl in Table 16. Further, the Boger et al. reference also discloses physiological and physical effects by PPO-inhibitors on plants and other characteristics of PPO enzyme inhibitors at page 235 of the reference. Such PPO enzyme inhibitors are disclosed for controlling such vines as morning glory (see page 259, column 2, line 13 and lines 22-23) and tree vegetation such as on fruit trees (see page 259, column 2, 3rd and 4th lines from bottom.)

The use of PPO enzyme inhibiting herbicides is recited in the method claims 1, 5, 6, 7 and 10 of US '915. The method of using oxyfluorfen is specifically recited in claim 5 of US '915. The method of using pyraflufen-ethyl is specifically recited in claim 5 of US '915. The method of using carfentrazone-ethyl is specifically recited in claims 5, 6, 7, 9, and 12 of US '915.

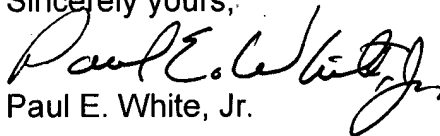
The sole independent claim 1 recites the use of all PPO enzyme inhibiting herbicides for control of ground shoots of vines and other trunk vegetation, and thus the Boger et al. reference renders all US '915 claims to be unpatentable. Those claims whose scope specifically includes oxyfluorfen or pyraflufen-ethyl or carfentrazone-ethyl are further unpatentable.

Thus, the above discussed references explicitly show the use of herbicides including oxyfluorfen or carfentrazone-ethyl or pyraflufen-ethyl for controlling unwanted ground shoots of vines and other trunk vegetation. The above references disclose PPO enzyme inhibiting herbicides for controlling unwanted ground shoots of vines and other trunk vegetation. A person skilled in the art would have been motivated to replace oxyfluorfen or carfentrazone-ethyl or pyraflufen-ethyl with another PPO enzyme inhibitor herbicides as recited in the claims of US '915 to result in methods for controlling unwanted ground shoots of vines and other trunk vegetation.

The above discussed references show the claims of US '915 including oxyfluorfen or carfentrazone-ethyl or pyraflufen-ethyl within their scope of PPO inhibiting herbicides to be anticipated, obvious and unpatentable, and further renders the claims including all PPO inhibiting herbicides to be anticipated, obvious and unpatentable.

Please contact me if you have any questions.

Sincerely yours,



Paul E. White, Jr.

Enclosures